Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD PODOSEK

Appeal No. 2000-1871
Application No. 08/907,398

ON BRIEF

Before CALVERT, COHEN, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 36, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates "generally to loose leaf binders, portfolios and similar paper storage items and relates more particularly to a novel paper storage item and method of making the same" (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Moor et al. (Moor)	5,219,437	June 15, 1993
Desmarais et al. (Desmarais)	5,449,428	Sep. 12, 1995

Claims 1 to 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moor in view of Desmarais.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the first Office action (Paper No. 5, mailed December 28, 1998) and the answer (Paper No. 12,

mailed April 26, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed February 8, 2000) and reply brief (Paper No. 3, filed May 8, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). In considering the question of

the obviousness of the claimed invention in view of the prior art relied upon, we are guided by the basic principle that the question under

35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). That is, the question of obviousness cannot be approached on the basis that an artisan having ordinary skill would have known only what they read in the references, because such artisan is presumed to know something about the art apart from what the references disclose. See In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). It is not necessary that suggestion or motivation be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ

545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985). We are bound to consider the disclosure of each reference for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); and In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968).

Moor's invention relates to a fabric covered book cover having front and back leafboards and a spine wherein both leafboards are covered with a fabric material. One characteristic feature of Moor's book cover is that the spine includes a plurality of longitudinal parallel seams which permit the spine to curl slightly and to fit comfortably in the cupped palm of the hand. As shown in Figures 1-7, book cover 10 comprises a front leafboard 11, a back leafboard 13, and a spine 16. The front leafboard comprises three outside edges 11a, 11b and 11c and an internal edge 22a. The back

leafboard comprises three outside edges 13a, 13b and 13c, and an internal edge 22b. The book cover 10 has an inside fabric surface 14 and outside fabric surface 12. In Moor's preferred embodiment, the inside and outside fabric surfaces are woven nylon or another synthetic material. The front leafboard includes a first stiffening member (not shown) which is about the same size as the front leafboard 11 and is retained immediately inside the three outside edges of the front leafboard 11a, 11b and 11c, and the internal edge 22a. The back leafboard 13 includes a second stiffening member 24 (Figure 6) which corresponds in size substantially to the back leafboard 13 and is retained immediately inside the three outside edges of the back leafboard 13a, 13b, and 13c, and the internal edge 22b. In Moor's preferred embodiment, the stiffening member comprises either cardboard, pressed paper, or the like.

Moor's first and second stiffening members are retained between the inside surface fabric 14 and the outside surface fabric 12 by a stitched peripheral seam 20 and stitched inner seams 22a and 22b. The book cover 10 includes a fabric spine

16 which connects and separates the front leafboard 11 from the back leafboard 13 and separates the first and second stiffening members. The spine 16 is made by stitching the inside fabric surface 14 and outside fabric surface 12 together with a plurality of longitudinal parallel seams 22. The parallel seams 22a and 22b are the outer edges of the spine 16. As illustrated in Figure 5, the spine 16 includes a padding member 23 encased between the inside fabric surface 14 and the outside fabric surface 12. The plurality of parallel seams 22 maintain a constant amount of the padding material 23 between each of the individual parallel stitched seams and allow the spine 16 to curl

flexibly such that it is easily cupped in the palm of the hand. The front leafboard 11 and the back leafboard fold about spine 16 to open and close the book cover.

As shown in Figures 3 and 7, Moor's book cover 10 also includes a pocket 36 made by stitching fabric material, which is similar to the fabric surface of the book cover, to the inside fabric surface 14 with an opening 37. The pocket 36 is designed to receive a 3-ring binder member 31 or a spiral notebook 29. An additional pocket 34 is created by stitching fabric material, which is similar to the fabric surface of the book cover, to the inside fabric surface 14 with a seam 35. The additional pocket 34 can vary in size and can be used for a variety of purposes, including, but not limited to, retain an additional notebook or to store additional supplies.

Desmarais' invention is directed to a method of welding, by high frequency or ultrasonic vibrations, an environmentally friendly thermoplastic material, the material being particularly suitable as a replacement for high frequency welding of polyvinyl chloride containing materials. Desmarais

teaches (column 2, lines 27-36) that the environmentally friendly thermoplastic material comprises a copolymer or copolymer-polymer mixture selected from the group consisting of ethylenevinylacetate (EVA) copolymer, an EVA copolymer and polyethylene, an EVA copolymer and polypropylene, and an EVA copolymer and polyethylene and polypropylene, with the proviso that the concentration of vinylacetate in the film is from about 12 to about 28% by weight. For convenience purposes, the above described film will be referred to as EVA film. Desmarais further teaches (column 3, lines 60-68; column 5, line 4, to column 6, line 14) that both PVC material and EVA film can be used as covering materials for ring binders.

Claims 1 to 9 and 20 to 22

We will not sustain the rejection of claims 1 to 9 and 20 to 22 under 35 U.S.C. § 103.

In the first Office action, the examiner stated (p. 2) that Moor discloses "at least three discrete stiffener (22), a matching pair of woven synthetic sheets 12, 14, a ring mechanism 31 secured to one of the front cover, the spine and

the rear cover of the binder cover." The appellant argues (brief, p. 17) that the applied prior art does not suggest the subject matter of claims 1 to 9 and 20 to 22 since the spine stiffening panel recited in these claims is not taught or suggested by the applied prior art. In the answer, the examiner states (p. 4) that Moor "clearly discloses a ring binder[1] having a three part stiffener in association with a matching pair of woven synthetic sheets which are connected by seams at their edges."

After careful consideration of the positions of the examiner and the appellant, we find ourselves in agreement with the appellant that the spine stiffening panel recited in claims 1 to 9 and 20 to 22 is not taught or suggested by the applied prior art. While Moor clearly teaches a front cover stiffening panel and a rear cover stiffening panel, it is our view that Moor's spine 16 does not include a spine stiffening panel. In that regard, while Moor's spine 16 does include a

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[1] As shown in Figure 3 of Moor, a 3-ring binder member 31 is retained in pocket 36 of Moor's book cover 10. Therefore, Moor's book cover 10 is not a ring binder.

plurality of parallel seams 22 as shown in Figure 5 defining a plurality of pockets made by stitching the inside fabric surface 14 and outside fabric surface 12 together with padding material 23 therebetween, it is our determination that the claimed spine stiffening panel recited in claims 1 to 9 and 20 to 22 is not readable on any of the structure of Moor's spine 16.

Since all the limitations of claims 1 to 9 and 20 to 22 are not suggested by the applied prior art for the reasons set forth above, the decision of the examiner to reject claims 1 to 9 and 20 to 22 under 35 U.S.C. § 103 is reversed.

Claim 10

We sustain the rejection of claim 10 under 35 U.S.C. § 103.

Claim 10 reads as follows:

> A binder cover comprising:
> (a) a front cover stiffening member;
> (b) a rear cover stiffening member spaced apart from and oriented parallel to said front cover stiffening member; and

> (c) a matching pair of woven synthetic sheets, said woven synthetic sheets being disposed on opposite sides of said front and rear cover stiffening members and being welded together around their respective peripheries.

Based on the examiner's analysis and review of Moor and claim 10, the examiner ascertained (first Office action, p. 2) that the only difference is the limitation that the woven sheets be welded together around their peripheries. With regard to this difference, the examiner then determined (first Office action, pp. 2-3) that

> it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the step of attaching the woven sheets of Moor et al by ultrasonically welding the sheets as taught by Desmarais et al as a well known type of securing the cover sheets together.

The appellant argues (brief, pp. 15-16; reply brief, pp. 2-4) that absent the use of impermissible hindsight, there is no motivation in the applied prior art to replace the stitching technique used in Moor to join together the two synthetic woven sheets with the ultrasonic welding technique taught by Desmarais. We do not agree. In that regard, in our view the applied prior art clearly teaches two alternative

techniques for securing the peripheries of two synthetic sheets together to form a binder cover. Moor teaches the technique of stitching the peripheries of two synthetic sheets together to form a binder cover and Desmarais teaches the technique of ultrasonically welding the peripheries of two synthetic sheets together to form a binder cover. Based on the applied prior teachings of two alternative techniques for securing the peripheries of two synthetic sheets together to form a binder cover, we conclude that it would have

been obvious at the time the invention was made to a person having ordinary skill in the art to have secured the peripheries of Moor's two synthetic woven sheets together by ultrasonically welding to form a binder cover for the known advantages thereof (e.g., less expensive to manufacture, less time consuming, easier to automate).

For the reasons set forth above, the decision of the examiner to reject claim 10 under 35 U.S.C. § 103 is affirmed.

Claims 11 to 19, 23 to 25 and 27 to 36

The decision of the examiner to reject claims 11 to 19, 23 to 25 and 27 to 36 under 35 U.S.C. § 103 is also affirmed since the appellant has not argued separately the patentability of any particular claim apart from the others, thus allowing claims 11 to 19, 23 to 25 and 27 to 36 to fall with claim 10 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); and 37 CFR § 1.192(c)(7) and (8)(iv)).

Claim 26

We will not sustain the rejection of claim 26 under 35 U.S.C. § 103.

Claim 26 recites a binder cover comprising, inter alia, a front cover stiffening member; a rear cover stiffening member; an outer synthetic woven sheet; and an inner synthetic sheet which is a continuous film. Claim 26 further recites that the inner and outer synthetic sheets are disposed on opposite sides of the front and rear cover stiffening members and are welded together around their respective peripheries.

Claim 26 was rejected on the same basis as set forth above with respect to claim 10 (see pages 2-3 of the first Office action which action was incorporated by reference on page 3 of the answer). The appellant argues (brief, p. 18) that welding together of an outer synthetic woven sheet to an inner synthetic continuous film sheet is not taught or suggested by the applied prior art. We agree. Moor clearly teaches stitching together of outer synthetic woven sheet to an inner synthetic woven sheet. Desmarais clearly teaches

welding together of an outer synthetic continuous film sheet to an inner synthetic continuous film sheet. Thus, there is no teaching or suggestion in the applied prior art to arrive at the subject matter of claim 26.

In the response to argument section of the answer, the examiner determined (p. 4) in regard to claim 26 that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form Moor's inner sheet as a continuous film. However, no evidence[2] has been cited by the examiner to support this determination, especially since

[2] Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

the evidence of record (i.e., Moor and Desmarais) teaches that the inner and outer sheets are made from the same material.

For the reasons set forth above, the decision of the examiner to reject claim 26 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 36 under 35 U.S.C. § 103 is affirmed with respect to claims 10 to 19, 23 to 25 and 27 to 36 and reversed with respect to claims 1 to 9, 20 to 22 and 26.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT Administrative Patent Judge	)	
IRWIN CHARLES COHEN Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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